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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,565	10/17/2001	Andrew C. Gilbert	01-1040	7706
63710 7590 12/20/2010 INNOVATION DIVISION CANTOR FITZGERALD, L.P. 110 EAST 59TH STREET (6TH FLOOR) NEW YORK, NY 10022				
EXAMINER TRAN, HAI				
ART UNIT		PAPER NUMBER		
3694				
MAIL DATE		DELIVERY MODE		
12/20/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/981,565

Applicant(s)

GILBERT ET AL.

Examiner

HAI TRAN

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG-06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 10/22/2010

DETAILED ACTION

1. This is the communication in response to the amendment filed on September 17, 2010, for application, titled; "Bid/Offer Spread Trading".

Status of the Claims

2. No claim has been amended. Claims 1-27 were cancelled previously. Accordingly, claims 28-46 are remain pending in this application and have been examined.

Information Disclosure Statement

3. The IDS submitted on 10/22/2010 is acceptable and a copy of the PTOL-1449 form with examiner's initials is enclosed.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 28 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. The claim is rejected because the preamble does not specify that the method is performed on a particular machine (i.e. computer, processor). Applicant is advised to amend the preamble to say "a computer-implement method", "a method implemented on a computer", or something similar to that.

7. Claims 40-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. Applicant recites "*A computer readable medium having stored thereon a plurality of instructions*"; however, Applicant's use of the phrase "computer readable medium" is broad enough to include both "transitory" and "non-transitory" media. Applicant's specification does not clearly explain the utilization of a non-transitory computer storage medium (see paragraph 31 "medium (e.g., air waves)"), and thus does not constitute functional description material. Hence, when the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter).

9. The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals *per se*, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the USPTO suggests the following approach. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim. *Cf. Animals - Patentability*, 1077 *Off. Gaz. Pat. Office* 24 (April 21, 1987) (suggesting that applicants add the limitation "non-

human" to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101). Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal *per se* is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure. *See, e.g., Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998).

Response to Arguments

10. With respect to arguments of I.A, Applicant's arguments have been considered and are persuasive. Hence, the 102 rejection in the previous Office Action is withdrawn.

11. With respect to arguments of I.B and I.C, the Examiner respectfully disagrees with Applicant. Applicant's comments are not directed to the examination. Applicant filed an RCE after the first two office action, so the examination was reopened. Then, after further two office actions, Applicant filed a Notice of Appeal on 7/15/2009 and the Examiner was waiting for the Applicant to file an Appeal Brief and would respond to it. However, for whatever the reason it is Applicant interviewed examiner's supervisor and without any feedback to the examiner, the application was reopened for prosecution. Applicant filed an Interview Summary on 1/14/2010 simply stating that the appeal does not appeal-worthy without informing the examiner what the reasons or bases are. As

today, the Examiner still does not know what the reason it is to vacate the office action. The Examiner would like ask the Attorney who is not following the rules? Applicant has the option to appeal after two office actions and if Applicant changes his mind during the appealing process, Applicant should and should have informed the Examiner the reasons for vacating the Office Action so that the Examiner can perform a thorough examination job. Applicant's frustration and try to take it out on the Examiner will not help the prosecution of the application.

Allowable Subject Matter

12. Claims 28-46 would be allowable if rewritten to overcome the rejection(s) in this Office action and if the Examiner does not discover any new reference(S).

Conclusion

13. Claims 28-46 are rejected.
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI TRAN whose telephone number is (571)272-7364. The examiner can normally be reached on M-F, 9-4 PM.
15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3694

/H. T./
Examiner, Art Unit 3694